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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,799	09/18/2003	Robert M. H. Dunn	CA920030059US1	9024

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EXAMINER

DAYE, CHELCIE L

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,799	<b>Applicant(s)</b> DUNN ET AL.	
	<b>Examiner</b> Chelcie Daye	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 22-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is issued in response to applicant's amendment filed September 18, 2006.
2. Claims 1-37 are presented. Claims 22-37 are added and claims 6-21 are cancelled.
3. Claims 1-5 and 22-37 are pending.
4. Applicant's arguments filed September 18, 2006, have been fully considered but they are not persuasive.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4,25,30,and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claims 4,25,30, and 35 recite, "one or more virtual stores can elect to not have available one or more of the different versions of the particular asset". There is no support within the specification of an election taking place, in order for the virtual stores to have or not have available the different versions of the asset. It is unclear to

the examiner as to how the applicant is ascertaining the results of this particular limitation, since there is no support within the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 4,25,30, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly amended claims 4,25,30, and 35 are rejected under 35 U.S.C. 112, second paragraph, for having negative limitations, which are not clearly pointed out within the description. The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because

each recited limitation was definite. In *re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation “incapable of forming a dye with said oxidized developing agent” was definite because the boundaries of the patent protection sought were clear. In *re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his

invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form. Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**10. Claims 1-5 and 22-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nowers (US Patent Application No. 20030033205) published February 13, 2003.**

Regarding Claims 1,22,27,and 32, Nowers discloses a method of accessing data regarding commerce assets such as products or services offered at virtual stores participating in a virtual marketplace, the assets being organized

by types, each type being enabled to include all versions of an asset, said method comprising the steps of:

establishing a storepath relationship to correlate asset types among the virtual stores ([0089], Nowers)<sup>1</sup>;

consulting the storepath relationship for the asset type of a particular asset upon receiving a query from a user, the query including the particular asset and a particular virtual store indicating the virtual store at which the user desires to shop (Fig.3b; [0110], lines 6-12 and [0111], Nowers); and

returning data representing all the versions of the particular asset to the user as a response to the query (Fig.3c; [0112], lines 1-7, Nowers).

Regarding Claims 2,23,28,and 33, Nowers discloses the method wherein the data returned includes data representing availability of all the versions of the particular asset ([0112], lines 7-15 and [0113], Nowers)<sup>2</sup>.

Regarding Claims 3,24,29,and 34, Nowers discloses the method wherein the data returned further includes data representing the virtual stores that carry

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<sup>1</sup> Examiner Notes: The common pooled repository is an example of the relationship between the virtual stores and the global product catalog demonstrates the correlation among asset types.

<sup>2</sup> Examiner Notes: Figs.4a-b represents the properties page for the first product listed within the results page "Houndstooth dress sock". However, it is known that each product will have its own properties page, which displays an inventory section (Fig.4b, item 108); wherein the availability of the product is stored ([0118], Nowers).

versions of the particular asset as well as a price of the versions of the particular asset for comparison shopping (Fig.7d; [0165], Nowers)<sup>3</sup>.

Regarding Claims 4,25,30,and 35, Nowers discloses the method wherein one or more virtual stores can elect to not have available one or more of the different versions of the particular asset ([0094], Nowers).

Regarding Claims 5,26,31,and 36, Nowers discloses the method wherein when the user buys one of a particular asset or one of the virtual stores adds to the availability of the particular asset, the availability of the particular asset is dynamically updated ([0196-0197], Nowers).

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<sup>3</sup> Examiner Notes: Figs.7e-f discloses the properties pages associated with each product. Within the properties page is "pricing" section, which provides a price for the product. Therefore, simply the user observing the differences within the products and making a decision from the results performs comparison shopping.



***Other Prior Art Made of Record***

Ferguson et al. (US Patent No. 5,966,697) discloses a method for shopping at a variety of different vendors easily and securely. A user first selects a merchant and receives product information from the merchant. The user may select products from the merchant along with options for the selected items.

Freeny et al. (US Patent No. 6,076,071) discloses an automated product pricing system including a physical store system, a virtual store system, and a control system. The control system generates price change data including a changed price of an identified product based on the sales data received from at least one of the physical and virtual store systems.

***Response to Arguments***

Applicant's arguments with respect to the newly amended limitations of claim 1, such as "establishing a storepath relationship to correlate asset types among the virtual stores", "consulting the storepath relationship for the asset type of a particular asset upon receiving a query from a user", and "representing all the versions of the particular asset to the user as a response to the query", have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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